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GROUP 1600

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facsimile transmittal

OFFICIAL

To: Examiner K. Padmanabhan (Art Unit 1641) Fax: (703) 872-9306

From: Theodore J. Leitereg Date: October 31, 2002

Re: Serial No. 09/919,062 (Att'y Docket No. 10004377-1) Pages: 8 (including cover sheet)

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Notes: The documents accompanying this cover sheet are:

Transmittal Letter (in duplicate)

Response to Restriction Requirement



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AGILENT TECHNOLOGIES, INC.

Legal Department, DL429

Intellectual Property Administration

P. O. Box 7599

Loveland, Colorado 80537-0599

PATENT APPLICATION

ATTORNEY DOCKET NO. 10004377-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Donald J. Schremp, et al.

Serial No.: 09/919,062

Examiner: K. Padmanabhan

Filing Date: July 30, 2001

Group Art Unit: 1641

Title: CONTAINERS FOR SUPPORTS COMPRISING BIOPOLYMERS

COMMISSIONER FOR PATENTS

Washington, D.C. 20231

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- (X) Response/Amendment () Petition to extend time to respond
 () New fee as calculated below () Supplemental Declaration
 (X) No additional fee (Address envelope to "Box Non-Fee Amendments")
 () Other: _____ (fee \$ _____)

| CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY | | | | | | |
|--|--|------------------------|--|-------------------------|-------------|---------------------------|
| (1) FOR | (2) CLAIMS REMAINING AFTER AMENDMENT | (3) NUMBER EXTRA | (4) HIGHEST NUMBER PREVIOUSLY PAID FOR | (5) PRESENT EXTRA | (6) RATE | (7) ADDITIONAL FEES |
| TOTAL CLAIMS | | MINUS | | = 0 | X \$18 | \$ 0 |
| INDEP. CLAIMS | | MINUS | | = 0 | X \$84 | \$ 0 |
| [] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM | | | | | + \$280 | \$ 0 |
| EXTENSION FEE | 1ST MONTH \$110.00 | 2ND MONTH \$400.00 | 3RD MONTH \$920.00 | 4TH MONTH \$1440.00 | | \$ 0 |
| OTHER FEES | | | | | | \$ |
| TOTAL ADDITIONAL FEE FOR THIS AMENDMENT | | | | | | \$ 0 |

Charge \$ 0 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 50-1078 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this sheet is enclosed.

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Date of Facsimile: Oct. 31, 2002

Typed Name: Theodore J. Leitereg

Signature: 

Respectfully submitted,

Donald J. Schremp, et al.

By 

Theodore J. Leitereg

Attorney/Agent for Applicant(s)

Reg. No. 28,319

Date: Oct. 31, 2002

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Signature



Date

10/31/02

Name

Theodore J. Leitereg

PATENTS

Attorney Docket No. 10004377-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Donald J. Schremp, *et al.*

Serial No.: 09/919,062

Group Art Unit: 1641

Filed: July 30, 2001

Examiner: K. Padmanabhan

Title: CONTAINERS FOR SUPPORTS COMPRISING BIOPOLYMERS

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

This is responsive to the Office Action dated October 1, 2002, from the U.S. Patent and Trademark Office in the above-identified patent application.

Restriction Requirement

The Examiner required restriction under 35 U.S.C. §121 as set forth in the Office Action.

Applicant respectfully traverses the grouping of the claims in the restriction

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requirement and proposes the following groups:

- Group I. Claims 1-42.
- Group II. Claims 43-52, as set forth by the Examiner as Group VII.
- Group III. Claims 53-62, as set forth by the Examiner as Group VIII.
- Group IV. Claims 63-64, as set forth by the Examiner as Group IX.
- Group V. Claims 65-67, as set forth by the Examiner as Group X.
- Group VI. Claims 68-70, as set forth by the Examiner as Group XI.

Proposed new Group I above essentially combines Groups I through VI as set forth by the Examiner in the restriction requirement. Applicant submits the following argument in support of proposed new Group I. Claims 26-35 are dependent on Claim 1, and the methods of Claims 26-35 for mixing materials on the surface of a support utilize the device of Claim 1. Step (a) of Claim 26 requires that at least one reagent be placed on the surface of the support of the device of Claim 1. Claim 1 recites that the support is confined in a housing of the device of Claim 1. Accordingly, the methods of Claims 26-35 are practiced only with the device of Claim 1. The Examiner asserts that the methods as claimed could be practiced with the surface of another device such as a microtiter plate and that the specific method steps of the claims in no way appear to require the specific components of the apparatus of the invention, thereby rendering the inventions distinct. Applicant respectfully disagrees. As mentioned above, the language of Claim 26 clearly requires that the materials be mixed on the surface of the support of the device of Claim 1. SD

Claims 36-38 are dependent on Claim 1, and the methods of Claims 36-38 for mixing materials on the surface of a support utilize the device of Claim 1. Step (a) of Claim 36 requires that at least one reagent be placed on the surface of the support of the device of Claim 1. Claim 1 recites that the support is confined in a housing of the device of Claim 1. Accordingly, the methods of Claims 36-38 are practiced only with the device of Claim 1. For the reasons set forth above with respect to Claims 26-35, the language of Claim 36 clearly requires that the materials be mixed on the surface of the support of the device of Claim 1. Thus, Claims 36-38 are properly included in proposed new Group I.

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Claim 39 is dependent on Claim 20, and the method for carrying out a binding reaction utilizes the device of Claim 20. Step (a) of Claim 39 requires that a sample be incubated with the surface of the support of the device of Claim 20, which is dependent on Claim 1. Both Claim 20 and Claim 1 are included in the Examiner's Group I. As mentioned above, Claim 1 recites that the support is confined in a housing of the device of Claim 1. Accordingly, the method of Claim 39 is practiced only with the device of Claim 20. For the reasons set forth above with respect to Claims 26-35, the language of Claim 39 clearly requires that the sample be incubated with the surface of the support of the device of Claim 1. Thus, Claim 39 is properly included in proposed new Group I.

Claims 40-41 are dependent on Claim 21, and the methods of Claims 40-41 for detecting the presence of a target polynucleotide utilize the device of Claim 21. Step (a) of Claim 40 requires that a sample be incubated with the surface of the support of the device of Claim 21, which is dependent on Claim 20 and in turn on Claim 1. Claim 21, Claim 20 and Claim 1 are included in the Examiner's Group I. As mentioned above, Claim 1 recites that the support is confined in a housing of the device of Claim 1. Accordingly, the method of Claim 40 is practiced only with the device of Claim 21. For the reasons set forth above with respect to Claims 26-35, the language of Claim 40 clearly requires that the sample be incubated with the surface of the support of the device of Claim 1. Thus, Claims 40-41 are properly included in proposed new Group I.

Claim 42 is dependent on Claim 21, and the method of Claim 42 for detecting the presence of a target polynucleotide utilizes the device of Claim 21. Step (a) of Claim 42 requires that a sample be incubated with the surface of the support of the device of Claim 21, which is dependent on Claim 20 and in turn on Claim 1. Claim 21, Claim 20 and Claim 1 are included in the Examiner's Group I. As mentioned above, Claim 1 recites that the support is confined in a housing of the device of Claim 1. Accordingly, the method of Claim 42 is practiced only with the device of Claim 21. For the reasons set forth above with respect to Claims 26-35, the language of Claim 42 clearly requires that the sample be incubated with the surface of the support of the device of Claim 21. Thus, Claim 42 is properly included in proposed new Group I.

In the restriction requirement the Examiner determined that the inventions of Groups I-XI are separate and distinct. According to M.P.E.P. 802.01 the term "distinct"

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means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they each may be unpatentable because of the prior art) (emphasis in original). Accordingly, whatever the final restriction requirement may be, it will involve the Examiner's determination at least implicitly that the inventions of the various groups are separately patentable over one other.

Accordingly, should the Examiner find art that anticipates the invention of one of the groups, the inventions of the other groups would be patentable over such art because the Examiner has determined that the inventions of the groups are separately patentable over one another. If this were not the case, then the restriction requirement would not be proper. As indicated above, the M.P.E.P. states that distinct inventions are patentable, i.e., novel and unobvious, over each other. Applicant recognizes that the M.P.E.P. does state, "though they each may be unpatentable because of the prior art." However, this language must only mean that there may be art that renders one of the inventions unpatentable and other art that renders another of the inventions unpatentable. The language cannot mean that art anticipating one of the inventions would also anticipate or render obvious the other inventions. If so, then the inventions of the separate groups would not be patentable over one another. Thus, whatever the Examiner concludes regarding the restriction requirement, each invention of the various groups is novel and unobvious over the inventions of the other groups. Otherwise, Applicant has the right to have all inventions, which are not novel and not unobvious over one another, examined in the same application.

Election of Invention

In response to the original restriction requirement and as required by the Office Action, Applicant elects the invention of the Examiner's Group I, Claims 1-25, as set forth in the original restriction requirement.

In making the above election, Applicant reserves the right to file divisional applications to the non-elected subject matter, which, as mentioned above, represents separately patentable inventions.

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SUMMARY

Applicant has traversed the original restriction requirement and has proposed new groups as discussed above. In addition, Applicant, as required in the Office Action, has elected the subject matter of Group I in response to the original restriction requirement.

Respectfully submitted,



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